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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,089	12/02/2003	David Byrne Reese	GCENP003	6003

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EXAMINER

POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/727,089	Applicant(s) REESE ET AL.	
	Examiner Melvin H. Pollack	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>see cont. sheet</u> . | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

DETAILED ACTION

New Examiner

1. A new examiner has been assigned this case. His contact information is provided below.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23 March 2006 has been entered.

Response to Arguments

3. Applicant's arguments with respect to claims 1-51 have been considered but are moot in view of the new ground(s) of rejection.
4. The 112 rejections are withdrawn in light of the amendments.
5. The original art rejections have been withdrawn in light of the amendment.

Specification

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 1, 2, 4, 6, 10-14, 16, 17, 19, 20, 22, 25-29, 31, 32, 34, 35, 37, 39, 43-47, 49, 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laster et al. (2001/0029478) in view of Capiel (6,449,634).

9. For claims 1, 19, 34, Laster teaches a method and system (abstract) for provisioning services within a message interchange network (Paras. 1-10), the method comprising:

- a. Providing the message interchange network (Figs. 1-3) having a plurality of services associated therewith (Paras. 38-54), each of which are accessible by others of the plurality of services (Fig. 2), each service representing one or more computer applications (Paras. 55 – 62) on one or more computing devices (Fig. 3, #100) accessible to other computing devices (Fig. 3, #92) through the message interchange network (Fig. 3, #96), the message interchange network being a hosted network (Paras. 61, 62, 127 and 160; the internet is buffered by various private LANs for buyers, sellers, and the auction network) overlaying a public network (Fig. 3, #98) and operable to mediate messages sent between the services so that each service receives messages in a format specified by the respective service (Paras. 367-370; XML wrapper if and only if on public network), without the senders of the messages being aware of the specified format (Para. 61);
- b. Receiving an offer pertaining to a service (Para. 152), the offer being created by a provider of the service to which the offer pertains (Paras. 236-353), and being transmitted from a first device to a service manager within the message interchange network (Paras. 55-57), the service manager being operable to track information pertaining to the offer (Para. 153) and to invitees that are invited to access the service of the offer (Paras. 206-

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217), and to set up permissions between an invitee and the service if the invitee accepts the offer (Paras. 142 – 181; customer must be registered and authenticated);

c. Receiving identifying information regarding one or more invitees to be invited to access the service of the offer (Paras. 161 – 188); and

d. In response to receipt of the offer and the identifying information regarding the one or more invitees (Para. 238), providing by the service manager an invitation regarding the one or more invitees to access the service of the offer through the message interchange network and based on the received identifying information (Para. 152).

10. Laster does not expressly disclose the one or more invitees being transmitted from the first device to the service manager. Capiel teaches a method and system (abstract) of providing invitations (col. 1, line 1 – col. 2, line 25) from a provider (Fig. 1, #112) to an invitee (Fig. 1, #142) via a third-party proxy server (Fig. 1, #130-134), such that the third party acts as a middleman (col. 2, line 65 – col. 3, line 20), wherein the provider sends a customer list and service information to the proxy (col. 3, lines 20-30), wherein the proxy uses the information to create an invite (col. 3, lines 30-60). At the time the invention was made, one of ordinary skill in the art would have added Capiel's methods to Laster in order to improve targeted advertising by utilizing prior customer information (col. 1, lines 20-30), and further to improve targeted advertising by creating invites crafted for a particular user's tastes and hardware (col. 1, lines 40-60).

11. For claims 2, 20, 35, Laster teaches that the invitation is provided in the form of an email (Para. 152).

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12. For claims 4, 22, 37, Laster teaches providing a unique URL address (Uniform Resource Locator) for each one or more invitees (Paras. 146-152), and providing the corresponding URL address in the each invitation to each invitee, wherein the URL address points to one or more web pages which allows the each invitee to register identifying information and accept terms of the offer (Para. 142).

13. For claims 6, 39, Laster teaches that the each invitation is provided by a provisioning service implemented on the service manager (Para. 238).

14. For claims 7, 24, 40, Laster teaches storing the offer and its associated one or more invitees (Fig. 1, esp. Fig. 1, #10 and 14).

15. For claims 10, 25, 43, Laster teaches presenting a registration input form to a first invitee of the one or more invitees for the offer when the first invitee accesses the invitation (Paras. 161-180).

16. For claims 11, 26, 44, Laster teaches that the identifying information received for the first invitee is pre-filled into the presented registration form (Para. 185).

17. For claims 12, 27, 45, Laster teaches that the invitation to the each one or more invitees further allows the each one or more invitees to accept the invitation (Fig. 7, #130).

18. For claims 13, 28, 46, Laster teaches presenting an acceptance link to the first invitee when the invitee submits the registration form with identifying information (Paras. 183-186).

19. For claims 14, 29, 47, Laster teaches setting up permissions between the first invitee and the service when the first invitee registers and accepts the offer (Para. 181).

20. For claims 16, 31, 49, Laster teaches that the method further comprises:

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- a. When the first invitee accepts the first offer, storing an indicator that the first invitee accepted the offer and the date of such acceptance (Para. 181);
 - b. When the first invitee does not accept the offer, storing an indicator that the first invitee did not accept the offer (Para. 188);
 - c. When the first invitee registers, storing an indicator regarding the registration and the date of such registration (Paras. 185 and 186); and
 - d. When the first invitee does not register, storing an indicator that the first invitee did not register (Paras. 185 and 186).
21. For claims 17, 32, 50, Laster teaches providing the indicator regarding the acceptance, the date of acceptance by the first invitee, and the indicator regarding registration to the provider queries regarding the first invitee or the offer (Paras. 188 and 189).
22. Claims 3, 5, 8, 9, 15, 18, 21, 23, 30, 33, 36, 38, 41, 42, 48, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laster and Capiel as applied to claims 1, 19 and 34 above, and further in view of Abendroth (2002/0087371).
23. For claims 3, 21, 36, Laster and Capiel do not expressly disclose that the invitation is provided in the form of a message or an FTP (file transfer protocol) drop. Abendroth teaches a method and system (abstract) of using a third party system to create and forward invitations between vendors and clients (Paras. 1-21) that fulfills this limitation (Para. 10). At the time the invention was made, one of ordinary skill in the art would add Abendroth's auction system to Laster's auction system in order to ensure integration between vendors and clients (Para. 9).

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24. For claims 5, 23, 38, Lastier and Capiel do not expressly disclose that the unique URL address is provided to the provider by a provisioning service implemented on the service manager, and wherein the provider sends the each invitation to each of the one or more invitees. Aberdroth teaches this limitation (Para. 66). At the time the invention was made, one of ordinary skill in the art would add Abendroth's auction system to Laster's auction system in order to ensure integration between vendors and clients (Para. 9).

25. For claims 8, 41, Lastier and Capiel do not expressly disclose that the offer and its associated one or more invitees are only stored when the provider is authorized to create the offer, and wherein the invitation is only provided to the one or more each invitees when the provider is authorized to create the offer. Abendroth teaches this limitation (Paras. 64-65). At the time the invention was made, one of ordinary skill in the art would have added Abendroth vendor authentication for security purposes (Para. 20).

26. For claims 9, 42, Lastier, Capiel and Abendroth do not expressly disclose sending an error message to the provider when the provider is not authorized to create the offer.

27. Examiner takes Official Notice (see MPEP § 2144.03) that "error message notifications" in a computer networking environment was well known in the art at the time the invention was made. It would have been obvious to one of ordinary skill in the art to use error messages for the purpose of notifying authorization problems to block intruders, and further to warn legitimate users of potential problems. Further, it increases user comprehension and acts as a convenient method of providing such information.

28. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d

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724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

29. For claims 18, 33, 51, Laster teaches that the registration form is presented to the first invitee by presenting an invitation page having a registration link (Figs. 5A and 5B), the method further comprising:

- a. Presenting an option link in the invitation page (Para. 142), wherein the option can be accessed by invitees which have already registered (Para. 144);
- b. Presenting an acceptance link to the first invitee when the invitee submits the registration form with identifying information (Figs. 6-9); and
- c. Presenting the acceptance link to the first invitee when the invitee selects the option link and the first invitee is already registered (Figs. 6-9).

23. For claims 15, 30, 48, Laster does not expressly disclose that permissions are not set up when the first invitee is not authorized to accept the offer. Abendroth teaches this limitation (Paras. 64-65). At the time the invention was made, one of ordinary skill in the art would have added Abendroth vendor authentication for security purposes (Para. 20).

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Conclusion

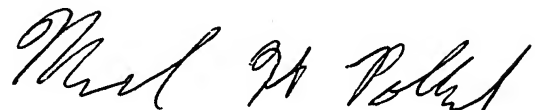
24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They regard further issues on providing third-party support for invitations to purchase goods and services.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MHP
22 June 2006


Melvin H. Pollack
2145

IDS Cont: 4/14/06, 3/23/06, 4/29/04